UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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3621	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/584,788	WINZENRIED ET AL.
	Examiner	Art Unit	
	JACOB C. COPPOLA	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *06 May 2010*.
2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *11,13-28,32-34 and 36-61* is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *11, 13-28, 32-34, and 36-61* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a) ☐ All   b) ☐ Some * c) ☐ None of:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____.
      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1.   This Office action is in reply to Applicants' response filed on 06 May 2010 ("2010 May

Response").

2.   Claims 11, 13-28, 32-34, and 36-61 are currently pending and have been examined.

3.   This Office Action is given Paper No. 20100712. This Paper No. is for reference

purposes only.

Claim Rejections - 35 USC §103

4.   The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been obvious at
> the time the invention was made to a person having ordinary skill in the art to which said subject
> matter pertains. Patentability shall not be negatived by the manner in which the invention was
> made.

5.   Claims 11, 14, 16, 17, 21, 24, 25, 32-34, 38, 39, 41, 43, 44, 46-48, 50, 53, 54, 56-58, and

60 are rejected under 35 U.S.C. §103(a) as being unpatentable over Cronce et al. (U.S. 7,032,240

B1) ("Cronce"), in view of Buchheit et al. (U.S. 2002/0031222 A1) ("Buchheit").

Regarding Claims 11 and 34

6.   Cronce discloses:

storing in a file ("authorization log file") on a first computer ("host system **110**") to

which a first dongle ("portable authorization device **140**") is connected via an interface ("host

system interface circuit **145**") parameters ("authorization log file" contains "reconstruction data") associated with an authorization code stored on the first dongle ("reconstruction data" is associated with "authorization information stored on the portable authorization device **140**"), but not storing in the file the authorization code ("authorization log file does not contain the items of authorization information themselves") (see at least c. 5, ll. 17-34; c. 7, ll. 35-50; and c. 22, l. 55 – c. 23, l. 24);

      sending the parameters to an authorized party; after sending the parameters, receiving a restored authorization code; and storing the restored authorization code in a second dongle (c. 22, l. 55 – c. 23, l. 24).

7.   Cronce does not directly disclose:

      sending the parameters to a second computer;

      after sending the parameters, receiving a restored authorization code at the first computer in a format that can be interpreted only by the dongle and not by the first computer; and

      storing the restored authorization code in a second dongle connected to the first computer.

8.   Cronce teaches:

      sending data to a second computer that is an authorized party ("networked indirect information authority **185**," *e.g.*, "computer server") (see at least c. 5, ll. 53-65 and c. 7, ll. 36-50).

9.   Buchheit teaches:

sending, from a first computer, parameters to a second computer (see discussion in ¶

0055 of parameters sent through internet to licenser; see also ¶ 0038 for description of licenser as

a server; see also fig. 1 showing licensers as computers on a network);

after sending the parameters, receiving an authorization code ("Firm Item Creation

Sequence" is received at licensee; sequence is composed of authorization keys for authorizing

use of software) at the first computer ("licensee" is a computer) in a format that can be

interpreted only by a dongle and not by the first computer ("Firm Item Creation Sequence" can

only be decrypted by a private key stored in a dongle (*i.e.*, the "protective device **3**" of at least ¶

0050) making the sequence only interpretable by the dongle, not the licensee computer) (see at

least ¶¶ 0057-0061; and fig. 1 with associated text; see also abstract); and

storing the authorization code in the dongle connected to the first computer (see at least ¶

0050).

10.   Therefore, it would have been obvious to one of ordinary skill in the art, at the time the

invention was made, to modify the method steps of Cronce to include the steps of Buchheit

implemented in a first and second computer configuration, much like the host and information

authority configuration of Cronce, in order to implement Cronce's restoration of the

authorization codes over a network. Additionally, it would have been obvious to one of ordinary

skill in the art, at the time the invention was made, to use the format of Buchheit with the

authorization codes of Cronce in order to ensure "that no unauthorized person can decode the

[authorization codes]." See Buchheit at ¶ 0058.

Regarding Claims 14, 16, 17, 32, 38, 39, and 41

11.   The combination of Cronce and Buchheit discloses the limitations of claims 11 and 34, as

shown above, and further discloses the limitations of:

Claim 14: The method according to Claim 11, further comprising: receiving from the first

computer the parameters at the second computer; evaluating the parameters; and deciding with

the second computer whether or not to return to the first computer the restored authorization

code (Cronce: c. 22, l. 55 – c. 23, l. 24);

Claims 16 and 38: The method according to Claim 11, wherein several authorization

codes for licenses, at least one for each of a plurality of licensors are stored on the dongle (see

Cronce: c. 5, ll. 17-36 & c. 6, ll. 17-32; see also Buchheit: fig. 1 & ¶¶ 0017, 0025, & 0040);

Claims 17 and 39: The method according to Claim 11, further comprising establishing a

remote data connections to a computer associated with each of the several licensors, in order to

permit sending to each of the licensors parameters associated with the licensor, and receive from

the several licensors restored authorization codes (see Cronce: c. 5, ll. 17-36, c. 6, ll. 17-32, and

fig. 1 with associated text; see also Buchheit: fig. 1 with associated text);

Claim 32: The method according to claim 11, wherein the authorization code is storable

only on the access-protected data processing device (Cronce: c. 7, ll. 36-50); and

Claim 41: The computer readable medium of claim 34, wherein sending with the first

computer the read license parameters further comprises: establishing a remote data connection

between the computer of the licensee and a computer of the licensor (Cronce: fig. 1 with

associated text; see also Buchheit: fig. 1 with associated text).

Regarding Claim 21

12.   Cronce discloses:

storing in a file ("authorization log file") on a computer of a licensee ("host system **110**")

to which a first dongle ("portable authorization device **140**") is connected via an interface ("host

system interface circuit **145**") license parameters ("authorization log file" contains

"reconstruction data") associated with an authorization code stored on the first dongle

("reconstruction data" is associated with "authorization information stored on the portable

authorization device **140**") (see at least c. 5, ll. 17-34; c. 7, ll. 35-50; and c. 22, l. 55 – c. 23, l.

24);

reading of the license parameters associated with the authorization code from the file (c.

22, l. 55 – c. 23, l. 24);

sending the license parameters to an authorized party; receiving the license parameters at

the authorized party; evaluating the license parameters at the authorized party; in response to

receiving the license parameters, restoring a restored authorization code corresponding to the

received license parameters at the authorized party; and storing the restored authorization code

on a second dongle (c. 22, l. 55 – c. 23, l. 24)

13.   Cronce does not directly disclose the authorized party is a computer of a licensor;

returning the restored authorization code to the computer of the licensee in a format that can be

interpreted by the dongle and that cannot be interpreted by the computer of the licensee; and a

second dongle connected to the computer of the licensee.

14.   Cronce teaches:

sending data to a computer controlled by an authorized party ("networked indirect

information authority **185**," *e.g.*, "computer server" used by "vendor") (see at least c. 5, ll. 53-65

and c. 7, ll. 36-50).

15.   Buchheit teaches:

a computer of a licensor connected to a computer of a licensee via a network (see at least

fig. 1);

sending, from the computer of the licensee, licensing parameters to the computer of the

licensor (see discussion in ¶ 0055 of parameters sent through internet to licenser; see also ¶ 0038

for description of licenser as a server; see also fig. 1 showing licensers as computers on a

network);

after sending the parameters, returning an authorization code ("Firm Item Creation

Sequence" is received at licensee; sequence is composed of authorization keys for authorizing

use of software) to the computer of the licensee ("licensee" is a computer) in a format that can be

interpreted by a dongle and that cannot be interpreted by the computer of the licensee ("Firm

Item Creation Sequence" can only be decrypted by a private key stored in a dongle (*i.e.*, the

"protective device **3**" of at least ¶ 0050) making the sequence only interpretable by the dongle,

not the licensee computer) (see at least ¶¶ 0057-0061; and fig. 1 with associated text; see also

abstract); and

storing the authorization code in the dongle connected to the computer of the licensee

(see at least ¶ 0050).

16.   Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the method steps of Cronce to include the steps of Buchheit implemented in a licensee computer and licensor computer configuration, much like the host and information authority configuration of Cronce, in order to implement Cronce's restoration of the authorization codes over a network. Additionally, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use the format of Buchheit with the authorization codes of Cronce in order to ensure "that no unauthorized person can decode the [authorization codes]." See Buchheit at ¶ 0058.

Regarding Claims 24, 25, and 33

17.   The combination of Cronce and Buchheit discloses the limitations of claim 21, as shown above, and further discloses the limitations of:

Claim 24: The method according to Claim 21, wherein several authorization codes for licenses of several licensors are stored on the dongle (see Cronce: c. 5, ll. 17-36 & c. 6, ll. 17-32; see also Buchheit: fig. 1 & ¶¶ 0017, 0025, & 0040);

Claim 25: The method according to Claim 24, wherein remote data connections are established to computers for the several licensors, in order to permit each of the several licensor to evaluate parameters and to restore to the second dongle corresponding restored authorization codes (see Cronce: c. 5, ll. 17-36, c. 6, ll. 17-32, and fig. 1 with associated text; see also Buchheit: fig. 1 with associated text); and

Claim 33: The method of claim 21, wherein the file does not store the authorization code ("authorization log file does not contain the items of authorization information themselves") (c. 22, l. 55 – c. 23, l. 24).

Regarding Claims 43 and 53

18.   Cronce discloses:

reading from a first dongle ("portable authorization device **140**"), which is connected via an interface ("host system interface circuit **145**") to a first computer used by a licensee ("host system **110**") and storing an original authorization code ("authorization information"), parameters associated with a license from the licensor to the licensee ("reconstruction data") (see at least c. 5, ll. 17-34; c. 7, ll. 35-50; and c. 22, l. 55 – c. 23, l. 24);

storing on the first computer the parameters read from a first dongle (see at least c. 22, l. 55 – c. 23, l. 24);

upon the dongle becoming lost or defective, sending the parameters to an authorized party; after sending the license parameters, receiving a restored authorization code; and storing the restored authorization code on a replacement dongle (see at least c. 22, l. 55 – c. 23, l. 24).

19.   Cronce does not directly disclose the authorized party is a second computer; receiving a restored authorization code at the first computer in a format that can be interpreted only by a replacement dongle and not by the first computer; and a replacement dongle connected to the first computer.

20.   Cronce teaches:

sending data to a second computer that is an authorized party ("networked indirect

information authority **185**," *e.g.*, "computer server" used by "vendor") (see at least c. 5, ll. 53-65

and c. 7, ll. 36-50).

21.   Buchheit teaches:

a second computer of a licensor connected to a first computer of a licensee via a network

(see at least fig. 1);

sending, from the first computer, parameters to the second computer (see discussion in ¶

0055 of parameters sent through internet to licenser; see also ¶ 0038 for description of licenser as

a server; see also fig. 1 showing licensers as computers on a network);

after sending the parameters, receiving an authorization code ("Firm Item Creation

Sequence" is received at licensee; sequence is composed of authorization keys for authorizing

use of software) at the first computer ("licensee" is a computer) in a format that can be

interpreted only by a dongle and that cannot be interpreted by the computer of the licensee

("Firm Item Creation Sequence" can only be decrypted by a private key stored in a dongle (*i.e.*,

the "protective device **3**" of at least ¶ 0050) making the sequence only interpretable by the

dongle, not the licensee computer) (see at least ¶¶ 0057-0061; and fig. 1 with associated text; see

also abstract); and

storing the authorization code in the dongle connected to the computer of the licensee

(see at least ¶ 0050).

22.   Therefore, it would have been obvious to one of ordinary skill in the art, at the time the

invention was made, to modify the method steps of Cronce to include the steps of Buchheit

implemented in a first computer and second computer configuration, much like the host and

information authority configuration of Cronce, in order to implement Cronce's restoration of the

authorization codes to the replacement dongle over a network via Cronce's host computer.

Additionally, it would have been obvious to one of ordinary skill in the art, at the time the

invention was made, to use the format of Buchheit with the authorization codes of Cronce in

order to ensure "that no unauthorized person can decode the [authorization codes]." See

Buchheit at ¶ 0058.

Regarding Claims 44, 46-48, 50, 54, 56-58, and 60

23.   The combination of Cronce and Buchheit discloses the limitations of claims 43 and 53, as

shown above, and further discloses the limitations of:

        Claims 44 and 54: The method of claim 43, wherein the original authorization code is not

stored in the file (Cronce: c. 22, l. 55 – c. 23, l. 24);

        Claims 46 and 56: The method of claim 43, wherein the parameters are stored in an

encrypted form (Cronce: c. 22, l. 55 – c. 23, l. 24);

        Claims 47 and 57: The method of claim 43, wherein the parameters are associated with

first dongle and the original authorization code stored by the first dongle (Cronce: c. 22, l. 55 – c.

23, l. 24);

        Claims 48 and 58: The method of claim 43 further comprising: receiving at the second

computer the parameters from the first computer (see rejection to claim 43 – combination of

Cronce and Buchheit meet this limitation); evaluating the parameters (Cronce: c. 22, l. 55 – c.

23, l. 24); deciding with the second computer whether or not to restore an authorization code

based on the evaluation of the parameters (Cronce: c. 22, l. 55 – c. 23, l. 24); and generating the restored authorization code based on the parameters (Cronce: c. 22, l. 55 – c. 23, l. 24) and returning to the first computer the restored authorization code if it is decided to restore an authorization code (see rejection to claim 43 – combination of Cronce and Buchheit meet this limitation), and otherwise not returning an authorization code;

Claims 50 and 60: The method according to Claim 43, wherein reading from a first dongle parameters associated with a license from the licensor to the licensee comprises reading parameters associated with a plurality of licenses, at least one license from each of a plurality of licensors (see at least Cronce: c. 5, ll. 17-36 & c. 6, ll. 17-32 showing that authorization codes from multiple vendors are stored on the dongle; see also Buchheit: fig. 1 & ¶¶ 0017, 0025, & 0040);

wherein, upon the dongle becoming lost or defective, parameters stored in the first computer for each of the plurality of licenses is sent, respectively, to a computer of each of the licensor issuing the license to which the parameters are associated (As shown above in the rejection to claim 43, it would be obvious for the parameters of Cronce to be sent to a computer of a licensor, as taught by Buchheit. Additionally, Cronce and Buchheit both allow for communication between a computer of the licensee and computers of multiple licensors. See, e.g., Cronce fig. 1 and c. 6, ll. 17-32. Therefore, when combining Cronce and Buchheit, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to additionally modify Cronce to send the parameters to each licensor having authorization information originally stored on the dongle in order to restore all authorization information from all vendors);

wherein, the first computer receives from at least one of the computers of the plurality of licensors a restored authorization code in a format that can be interpreted only by the replacement dongle and not by the first computer (this limitation is addressed in the rejection to claim 43); and

wherein the first computer stores each authorization code received from the plurality of licensors on the replacement dongle (this limitation is addressed in the rejection to claim 43).

24.   Claims 13, 15, 22, 23, 36, 37, 45, 49, 55, and 59 are rejected under 35 U.S.C. §103(a) as being unpatentable over Cronce, in view of Buchheit, and in further view of Pitman et al. (U.S. 2005/0132201 A1) ("Pitman").

Regarding Claims 13, 22, 36, 45, and 55

25.   The combination of Cronce and Buchheit discloses the limitations of claims 11, 21, 34, 43, and 53, as shown above, and further discloses:

wherein the parameters are stored at least partially in encrypted form in the file (Cronce: c. 22, l. 55 – c. 23, l. 24).

26.   The combination of Cronce and Buchheit does not directly disclose wherein the parameters are signed with time information for protection.

27.   Pitman teaches signing an electronic record with time information for protection (see at least fig. 7 with associated text).

28.   Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the storing of the file in Cronce by signing the parameters with

time information, as taught by Pitman, in order to verify that the parameters were signed by an

entity with a valid certificate (see Pitman: fig. 10).

Regarding Claims 15, 23, 37, 49, and 59

29.   The combination of Cronce and Buchheit discloses the limitations of claims 13, 21, 34,

43, and 53, as shown above, and further discloses generating the restored authorization code

(Cronce: c. 22, l. 55 – c. 23, l. 24).

30.   The combination of Cronce and Buchheit does not directly disclose communicating time

information stored in the file from the first computer to the second computer; evaluating the time

information at the second computer; and generating the restored authorization code based on the

time information.

31.   Pitman teaches communicating time information stored in a file from a first computer to a

second computer and evaluating the time information at the second computer to determine the

validity of a signature (see at least fig. 10 with associated text).

32.   Therefore, it would have been obvious to one of ordinary skill in the art, at the time the

invention was made, to modify the method of Cronce and Buchheit to include communicating

and evaluating time information, as taught by Pitman, in order to confidently generate the

restored authorization code knowing the file was created during a valid period and that the file

has not been tampered with (see Pitman: fig. 10).

33.   Claims 18-20, 26-28, 40, 42, 51, 52, and 61 are rejected under 35 U.S.C. §103(a) as being

unpatentable over Cronce, in view of Buchheit, and in further view of Ansell et al. (U.S.

6,792,113 B1) ("Ansell").

Regarding Claims 18, 26, and 40

34.   The combination of Cronce and Buchheit discloses the limitations of claims 11, 21, and

34, as shown above, and further discloses establishing data connections between multiple

computers on a network (see Cronce: at least fig. 1; see also Buchheit: at least fig. 1).

35.   Cronce and Buchheit do not directly disclose establishing a remote data connection

between the first computer and a central management computer; sending the file from the first

computer to the management computer; and establishing a data connection between the second

computer and at least the management computer.

36.   Ansell teaches a central management computer (see Authorization System 102 of at least

fig. 1) that stores licensing records (see at least fig. 19 with associated text) and that has an

established data connection between a first computer of a licensee (see fig. 1).

37.   Therefore, it would have been obvious to one of ordinary skill in the art, at the time the

invention was made, to include in the network of Cronce and Buchheit the management

computer as taught by Ansell, by establishing a connection between the first and second

computers and the management computer, since the claimed invention is merely a combination

of old elements, and in the combination each element merely would have performed the same

function as it did separately, and one of ordinary skill in the art would have recognized that the

results of the combination were predictable.

38.   Additionally, it would have been obvious to one of ordinary skill in the art, at the time the

invention was made, to send the file of Cronce to the management computer of Ansell for central

storage and authorization management.

Regarding Claims 19 and 27

39.   The combination of Cronce and Buchheit discloses the limitations of claims 18 and 27, as

shown above, and further discloses the limitations of:

       Claim 19: The method according to Claim 18, further comprising: establishing a remote

data connection between the first computer and the second computer for communicating the

restored authorization code from the second computer to the first computer (see rejection to

claim 11); and

       Claim 27: The method according to Claim 26, further comprising: establishing a remote

data connection between the computer of the licensee and the computer of the licensor (see

rejection to claim 21).

Regarding Claims 20, 28, 42, 51, 52, and 61

40.   The combination of Cronce and Buchheit discloses the limitations of claims 11, 21, 34,

43, and 53, as shown above, but does not directly disclose reading an unmodifiable serial number

of the dongle from the file; sending the serial number to a management computer; and storing the

serial number in a block list at the management computer.

41.   Ansell teaches reading an unmodifiable serial number (see "hardware identifier 140") of

a hardware device; sending the serial number to a management computer; and storing the serial

number in a block list at the management computer (see description of Authorization System 102 of at least fig. 1).

42.   Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include the serial number of Ansell in the file of Cronce and to send the serial number to a management computer as taught by Ansell, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

43.   Moreover, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the file of Cronce to include a serial number of the dongle of Cronce, as taught by Ansell, in order to bind the license identifiers to the specific dongle. Also, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use the management computer of Ansell in the system of Cronce to store the serial number in a file for later user in restoring the authorization information of Cronce because such a management computer provides a central location for managing issued devices.

Claim Interpretation

44.   After careful review of the original specification, the Examiner is unable to locate any lexicographic definitions with the required clarity, deliberateness, and precision. See MPEP §2111.01 IV.

45.   The Examiner finds that because the examined claims recite neither "step for" nor "means for," the examined claims fail Prong (A) as set forth in MPEP §2181 I. Because the

examined claims fail Prong (A) as set forth in MPEP §2181 I., the Examiner concludes that all

examined claims do not invoke 35 U.S.C. §112, 6th paragraph. See also *Ex parte Miyazaki*, 89

USPQ2d 1207, 1215-16 (B.P.A.I. 2008)(precedential).

46.   The Examiner hereby adopts the following definitions under the broadest reasonable

interpretation standard. In accordance with *In re Morris,* 127 F.3d 1048, 1056, 44 USPQ2d

1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his

interpretation of the claims.[1] Additionally, these definitions are only a guide to claim

terminology since claim terms must be interpreted in context of the surrounding claim language.

Finally, the following list is not intended to be exhaustive in any way:

enable "1 b. To make feasible or possible." The American Heritage® Dictionary of the

English Language, 4th ed. Boston: Houghton Mifflin, 2000;

permit "To afford opportunity or possibility for." Id.; and

send "3 b. To require or enable to go." Id.

Response to Arguments

47.   Applicants' arguments with respect to the examined claims have been considered but are

moot in view of the new grounds of rejection.

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[1] While most definitions are cited because these terms are found in the claims, the Examiner may
have provided additional definition(s) to help interpret words, phrases, or concepts found in the
definitions themselves or in the prior art.

Compliance with 37 C.F.R. §1.111(b)

48.   Applicants are respectfully reminded, 37 C.F.R. §1.111(b) requires applicants to

distinctly and specifically point out (in writing) the supposed errors of an Office action in

applicants' reply to the Office action, and also requires that applicants make a *bona fide* attempt

to advance the application to Final action.

49.   With respect to the art applied in the previous Office action mailed on 06 November

2009, the Examiner finds that Applicants have distinctly and specifically pointed out the

supposed errors made by the Examiner in applying the art, particularly in the application of

Downs (see 2010 May Response at pp. 12 & 13).

50.   Because Applicants have distinctly and specifically pointed out the supposed errors of the

previous Office action (mailed on 06 November 2009) in a timely manner by reducing them to

writing in the 2010 May Response, the Examiner finds that Applicants are currently compliant

with 37 C.F.R. §1.111(b). If, however, Applicants choose to argue other supposed errors in the

future that should have been argued in the 2010 May Response (*e.g.*, supposed errors relating to

the Examiner's application of Buchheit that could have been disputed in the 2010 May

Response), the Examiner will find that the 2010 May Response is in violation of 37 C.F.R.

§1.111(b) and a *non-bona fide* attempt by Applicants to advance this application to Final action.

Conclusion

51.   Applicants' amendment filed in the 2010 May Response necessitated the new grounds of

rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See

MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

52.   Because this application is now final, Applicants are reminded of the USPTO's after final

practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is

not a matter of right. "The refusal of an examiner to enter an amendment after final rejection of

claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed.

Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided

by the Examiner are just that—suggestions or examples—and do not constitute a formal

requirement mandated by the Examiner. Unless stated otherwise by an express indication that a

claim is "allowed," exemplary claim language provided by the Examiner to overcome a

particular rejection or to change claim interpretation has *not been addressed* with respect to other

aspects of patentability (*e.g.* §101 patentable subject matter, §112, first paragraph written

description and enablement, §112, second paragraph indefiniteness, and §102 and §103, prior

art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an

Examiner suggestion or example or simply changes claim interpretation will nevertheless require

further consideration and/or search and a patentability determination as noted above.

53.   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

54.   Applicants are respectfully reminded that any suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. To be especially clear, any suggestion or example provided in this Office Action (or in any future office action) does *not* constitute a formal requirement mandated by the Examiner.

a.   Should Applicants decide to amend the claims, Applicants are also reminded that—like always—no new matter is allowed. The Examiner therefore leaves it up to Applicants to choose the precise claim language of the amendment in order to ensure that the amended language complies with 35 U.S.C. §112, first paragraph.

b.   Independent of the requirements under 35 U.S.C. §112, first paragraph, Applicants are also respectfully reminded that when amending a particular claim, all claim terms must have clear support or antecedent basis in the specification. See 37 C.F.R. §1.75(d)(1) and MPEP §608.01(o). Should Applicants amend the claims such that the claim language no longer has clear support or antecedent basis in the specification, an objection to the specification may result. Therefore, in these rare situations where the amended claim language does *not* have clear support or antecedent basis in the specification and to prevent a subsequent 'Objection to the Specification' in the next office action, Applicants are encouraged to either (1) re-evaluate the amendment and change the claim language so the claims *do* have clear support or antecedent basis or, (2) amend the specification to ensure that the claim language does have clear support or antecedent basis. See again MPEP §608.01(o) (¶3). Should Applicants choose to amend the

specification, Applicants are reminded that—like always—no new matter in the specification is allowed. See 35 U.S.C. §132(a). If Applicants have any questions on this matter, Applicants are encouraged to contact the Examiner via the telephone number listed below.

55.   The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure (see attached form PTO-892). All references listed on form PTO-892 are cited in their entirety.

56.   Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

57.   Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/
Patent Examiner, Art Unit 3621
July 13, 2010

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621